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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 08/884146
Filing Date: 06/27/97
Appellant(s): Douglas P. Marquis

James P Ryther, Rudnick & Wolfe
For Appellant

MAILED

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GROUP 1700

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed December 20, 1999.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

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The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief states that all of the claims, i.e. 1-3 and 5 stand or fall together as one group.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,642,605	TENNER ET AL	7/97
2,201,524	ESTY	5/40

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Europ. Pat. 426963	MELITTA HAUSHALTSPR (hereinafter called MELITTA)	5/91
3,818,858	KRAMER	6/74
4,621,670	YUEN	11/86
French Pat. 877649	HAIN	12/41
2,685,860	PLAKAS	8/54
3,205,603	BRUMLEY	9/65
4,630,733	FEAR	12/86
5,690,273	JENSEN	11/97
3,392,468	WOLF	7/68
5,195,123	CLEMENT	3/93
4,733,780	JENSEN	3/88

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over appellant's admission of the prior art as further evidenced by Tenner et al, further in view of Esty, Melitta, Kramer, Yuen, Hain, Plakas, Brumley, Fear, Jensen ('273), Wolf and Clement.

In regard to claim 1, as evidenced by appellant's admission of the prior art found on pages 1 and 2 of appellant's specification and further evidenced by Tenner et al, it was

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conventional in the art to provide a bag for use as a proportioning bag for use in food operations wherein a bulk food supply would be divided into portions of smaller size, individual portions would be located in the bags and the bags would be closed for use at a later date wherein the bag is defined by exposed sidewalls and wherein the bag is provided with printing on at least one side wall; wherein the printing comprises a plurality of separate printed blocks positioned closely adjacent to each other (eg. Figure 1 of Tenner et al) and wherein the printing comprises a day of the week. See in this regard pages 1 and 2 of appellants specification wherein it is disclosed that the prior art either marked the bags with the day of the week representing the filling date or "use by" date, applied a printed and color coded label to the bag wherein the label was selected from a group of labels having the proper day of the week printed thereon, or applied printing directly to the bag which printing comprised a day of the week and was colored coated (page 2, para. 1 of appellant's specification and Tenner et al). Applicant's admission of the prior art further states that the label was an improvement over the marking pen because marking pens smudged or erased and the direct printed bag such as Tenner et al. was an improvement over the adhesive label process since applying the label took time. Claim 1 differs from appellants admission of the prior art as further evidenced by Tenner et al in that at least several days of the week are printed on the bag with each day being printed within a separate block, rather than having one day of the week as shown in Tenner et al. As disclosed, appellant's reason for printing several days on the storage bag, or, in the case of claim 2, all seven days of the week, printed on the storage bag is so that it is

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not necessary to hold in inventory separate sets of bags with each set dedicated to one day of the week. Appellant is not the first to provide a receptacle with indicia which allows one various choices to select various information or messages to be retained or communicated. The art is replete with examples wherein various receptacles for various uses are provided with indicia, mainly printed indicia, wherein a person has a varied selection of messages or communications or data that can be selected. These indicia include the names of the days of the week, the dates of the month, names of the month, etc. For example, Esty discloses applying indicia to a receptacle by printing directly on a can (page 2, col. 1, para. 4) wherein the consumer is provided with a plurality of indicia representing days of the week, dates in a month, etc so that the consumer can select the opening date of the receptacle and retain that information (see eg. figures 1 and 2 and col. 1, para. 4). Melitta discloses a food storage container for a freezer wherein the container has associated with it markings that name the months of the year so that the consumer can indicate the storage month by selecting the appropriate indicia. Note that Melitta does not teach providing twelve different sets of containers with each container set only having indicia representing one month but rather one set of containers with indicia representing all twelve months so that the consumer can select the appropriate month. This is, of course, appellants objective as well; ie. to provide one receptacle with a plurality of indicia choices rather than a series of different sets of receptacles with each set having only one indicia (ie no choice). Kramer is another food storage receptacle which gives one the ability to indicate when the food was placed in the receptacle

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for storage (col. 1, para 3) by providing the receptacle with a plurality of indicia, including printed indicia (col. 3, para. 2) indicating a plurality of months, dates and days of the week (eg. Figures 1 and 5). Yuen is a further example of storage containers which are provided with a plurality of indicia so that one can select the date including the month when the product is stored. The other references applied are applied as further evidence of providing a plurality of alternative indicia on the same receptacle to allow one the choice to convey or retain different information or messages-whether it is the degree of freshness of cheese from the time of packaging (Hain fig. 1), to the indication of the strength and sweetness of coffee in a cup (Plakas - Fig. 1 and Wolf - Fig. 1), to the ^{degree}~~edge~~ of doneness of a hamburger and what condiments are with it (Brumley - Figure 1); to the type of soft drink (Fear - Fig. 1); and finally to the type of food and condiments (Jensen '273-fig .7). It is noted that none of these references applied provide different sets of receptacles having only one indicia so that one would have a set of cups with the indicia "coffee - light - with sugar" and another set of cups with the indica "coffee-dark,- without sugar". Rather, like appellant, all of the secondary references provide receptacles with a plurality of indicia choices. Thus, appellants objective of providing a receptacle with indicia choices so that only one set of receptacles is necessary rather than a series of different sets is not the exception but the rule in the art and is fully documented by the art taken as a whole. To modify appellant's admission of the prior art as further evidenced by Tenner et al and provide the printed indicia storage bag of applicants admission and Tenner et al with a plurality of days or all seven days of the week (claim 2) for

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its art recognized and appellants intended function of providing one set of bags instead of one set of bags for each choice (i.e. day of the week) would have been unequivocally obvious in view of the art taken as a whole. The number of secondary references are thought to be necessary to provide evidence to emphasize the conventionality of receptacles provided with a plurality of indicia choices and their wide range of application and the information they provide. See *In re Gorman* 18 USPQ 2d series 1885 wherein the Court referring to an earlier case noted that “^{where}~~were~~ teachings relied upon to show obviousness ^{were}~~where~~ repeated in a number of references, the conclusion of obviousness was strengthened”. (*Kansas Jack, Inc. v. Kuhn* 719 F.2d 1144, 1149; 219 USPQ 857, 860 (Fed. Cir. 1983)). It is noted that claim 1 further recites that each day is printed in a different color which presumably ^{facilitates}~~facilitates~~ selection of the right day of the week by providing a color code (for people who cannot read?).

However, as noted above, appellants’ admission of the prior art acknowledges that it was conventional to color code the prior art labels so that each day of the week was a different color and Tenner et al prints on their bag each day of the week in a different color (col. 3, para. 2). In view of these facts, taken with the additional fact that appellant admits this color coding of days of the week is a conventional practice (page 4, para. 2), to further modify appellants admission of the prior art as evidenced by the Tenner et al bag and print each day in a different color for its art recognized and appellants intended function of color coding would therefore have been obvious. Finally, Clement, although disclosing a label for a medical procedure, nevertheless can be relied on as further evidence of the concept of providing indicia

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which offers one a selection, for example, by using a marker to mark off one of a plurality of possibilities (col. 10, para. 2). Although not part of the rejection it is interesting to note that although the claims do not recite how one is to indicate on the bag the particular printed indicia day, as disclosed, appellant in the specification suggests the use of a marker which, although he admits is conventional, is subject to smudging or erasing.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1, and further in view of Jensen ('780).

Claim 5 differs from the combination of references in the recitation that the bags are connected in a saddle arrangement supported on a saddle wherein the bags are connected by perforations so that the bags may be torn away one-at-a-time. As evidenced by Jensen ('780), it is well established in the art to provide bags in a paired, saddle arrangement with perforations therebetween so that the bags may be torn away one-at-a-time. See eg. figure 6 in this regard. This conventional dispensing arrangement is thus well established and Jensen ('780) discloses it has been used at deli counters (to load food into the bags), checkout registers, etc. To modify the combination and provide the printed bags in this conventional arrangement for its art recognized (ie. ease of dispensing) and appellants intended function for dispensing would therefore have been obvious.

(11) Response to Argument

All of appellant's remarks have been fully and carefully considered but are not found to be convincing. On page 7 of the Brief it is urged that none of the secondary references deal

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with food proportioning. Before dealing with the issue of food proportioning as it relates to the secondary references, it is first considered to be appropriate to make a few comments concerning the issue of "proportioning" in general for which appellant appears to give great weight to in his remarks. To some extent, appellant's urgings, directed to a method of proportioning, are directed to limitations not found in the claims. The claims are not directed to a method of food proportioning. The claims are directed to a bag capable of being used in a method of food proportioning. This is all claim 1 positively recites in this regard. The bag is empty with the process language being statements of intended use. However, even if the claims did positively recite a food in the bag or even a product by process claim, the urgings would still not be convincing. A food in a bag is just that - food in a bag. Whether the food could have been previously proportioned or not would be irrelevant to an article claim. The food placed in the bag could be newly made without any proportioning or the food ^{could} ~~would~~ be leftovers from one meal. That is, the bag with indicia thereon could be used to indicate the day of the week a single-serving meal was made, the day a leftover meal was brought home in a doggy-bag from a restaurant, etc. The issue of preportioning is also not convincing since appellant's admission of the prior art including Tenner et al discloses it is conventional in commercial operations to divide leftover prepared food into individual bags. It is noted that appellant as well as appellant's admission of the prior art including Tenner et al provide the indicia so that one can indicate either a date filled (or packaged) or a "use by" date. As noted

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above, this information would be appropriate whether the food placed in the bags had been pre-portioned from a larger amount of food or not.

Returning to appellant's urging that none of the secondary references deal with food preportioning and non teach appellants particular claimed subject matter, these urgings are not convincing. It is first noted that since appellants admission of the prior art including Tenner et al already teach fill date or "use by" indicia printed bags for use with food preportioning, it would not be necessary for the secondary references to teach the same exact utility for the rejection to be proper. It is of interest to note, however, that at least some of the secondary references including Melitta, Kramer and Yuen, although not disclosing whether the food has been preportioned, do disclose indicia containing receptacles whose utility is to indicate the storage time for foods (ie the fill date) which is, of course, appellants intended function as well. As fully detailed above, the secondary art has not been relied on to show bags to be used for pre-portioned foods which bags have at least several days of the week printed thereon. If the secondary art individually specifically showed this use of indicia, the rejection would have been under 35 U.S.C. 102, anticipation over the individual secondary art, instead of under 35 U.S.C. 103, obviousness, over appellants admission of the prior art as shown by Tenner et al in view of the secondary art taken as a whole. Without restating the rejection again, appellant's claim 1 differs from Tenner et al in that more than one day of the week and up to all seven days of the week are printed in printed boxes on the bag rather than the one day disclosed by Tenner et al. To modify Tenner et al and print some or all of the days of the

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week on a bag so that the specific day can be indicated would have been obvious in view of the art taken as a whole which shows various receptacles/packages with various indicia indicating all of the days of the week, the months of the year, the dates of the month and various other indicia so that the user of the receptacle (or the vendor) can be given a choice or various options to select a particular one or more of the indicia on the receptacle to impart a specific message or piece of information. Appellant's disclosed reason for printing indicia representing some or all of the days of the week rather than printing indicia representing only one day is to avoid having to have separate groups of bags for each day, and thus producing what could be termed a universal bag. The art taken as a whole teaches this concept. The secondary art teaches by providing a series of indicia indicating days, dates or other possible non-time indicia choices, one does not need to have different receptacles to indicate Tuesday as opposed to Wednesday, June as opposed to July or whether the receptacle contains black coffee without sugar as opposed to regular coffee with sugar. The art taken as a whole unequivocally teaches it would therefore have been obvious to modify appellants admission of the prior art as evidenced by Tenner et al and print several or all of the days of the week on the bag instead of just one day so that the user of the bag has the choice of marking which day he chooses without resorting to having to look for a separate bag with the appropriate day printed thereon.

On page 8, it is urged that the blocks are closely adjacent to each other and are printed in different colors. This urging has been discussed above in the body of the rejection.

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Tenner et al, for example, although disclosing a bag having only one day of the week printed on it does teach that the printed indicia for the name of the day are in boxes adjacent each other and the day is color coded to presumably the color convention disclosed by appellants admission of the prior art. To place indicia choices close together is, of course, not new. See Plakas, figure 1 and Clement (Fig. 1A). As for the color, since appellant's admission of the prior art discloses that the days were color coded by convention (page 1, para. 3, page 2, col. 1 and page 4, line 13), it would have been an obvious result effective variable to continue the conventional color coding of a different color for each day printed on the bag of Tenner et al modified by the secondary art taken as a whole.

In regard to the comments made in paragraph 2 on page 8 of the Brief, the point appellant is attempting to make is not understood. If appellant is urging Tenner et al is teaching away from appellant's invention (because he discloses only one day?), then this urging is not convincing. Whereas it is true that Tenner et al discloses bags printed with only one day of the week, there is nothing in Tenner et al which specifically rules out modification by the addition of additional days of the week to provide the user of the bag with indicia choices. The secondary references, if you will, can teach both the problem and its solution.

Finally, in the last paragraph on page 8 of the Brief, appellant urges that whereas the secondary references do teach providing printing which can be marked, the secondary references do not teach "to print in the particular manner now claimed". It is not clear what is meant by this phrase. If what is meant by the "manner now claimed," indicia comprising

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the days of the week in separate blocks and color coded, then this urging has been addressed above. Tenner et al teaches printing a day of the week in a block with the day of the week also being color coded. Tenner et al repeats the same day of the week on their bag; each indicia name in a separate block adjacent to each other. The art, taken as a whole, strongly suggests providing the bag or other receptacle with indicia choices so that one can use the same receptacle to indicate all possible filling dates, contents, etc.

In conclusion, a prima face case of obviousness has been set forth which has not been successfully rebutted, and it is respectfully submitted that for the reasons given above, the rejection is proper and should be sustained.

Any inquiry concerning this communication should be directed to Mr. Weinstein at telephone number (703) 308-0650.

Mr. Weinstein/om
March 31, 2000
April 6, 2000
April 11, 2000

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